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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/208,140	12/09/98	DEL VECCHIO	A P50743

020462 HM12/0426
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EXAMINER

ZEMAN, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

04/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/208,140

Applicant(s)

Del Vecchio

Examiner

Robert A. Zeman

Group Art Unit

1645



☒ Responsive to communication(s) filed on Dec 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) 1-13 and 16-18 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 14 and 15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3/5/99, 14-2100

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

Applicant's election, without traverse, of Group V in Paper No. 7 is acknowledged. Claims 1-13 and 16-18 are withdrawn from further consideration by the examiner as they are drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.

Claim Objections

Claim 14 is objected to because of the following informalities:

The claim appears to be a typographical error. Deletion of the "an" at the end of line 1 in said claim is suggested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 14 is vague and indefinite as it is dependent on a non-elected claim. Claim 14 must be rewritten to incorporate the scope and limitations of the non-elected independent claim.

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Claims 14 and 15 are rendered vague and indefinite by the use of the term "interaction". It is unclear what type of interaction is required. Is the interaction merely binding? Is a conformational change required? A chemical reaction? As written, it is impossible to determine the metes and bounds of the claimed invention.

Claims 14 and 15 are rendered vague and indefinite by the use of the phrase "which inhibit or which activate an the polypeptide". It is unclear what is meant by said phrase. What property or action of said polypeptide is being measured? What threshold must be overcome in order for inhibition or activation to have occurred? Also it is unclear whether there are separate steps required for the measurement of said polypeptide activity. As written, it is impossible to determine the metes and bounds of the claimed invention.

Inconsistent use of labels renders Claim 14 vague and indefinite. Specifically, in step a) of said claim, Applicant recites "with the compound". It is unclear whether applicant is referring to the candidate compound or another compound entirely. If Applicant is indeed referring to the candidate compound it is suggested that Applicant use the term "said compound" after the initial reference to the candidate compound.

Claim 15 is rendered vague and indefinite by the use of the term "capable of". Having the capacity to do something does not mean that is actually done. Consequently, it is impossible to determine the metes and bounds of the claimed invention.

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Use of the terms "the contacting step of (a)" and "the determining step of (b)" renders claim 15 vague and indefinite. Said terms imply that (a) and (b) contain multiple steps. Such is not the case. Use of the following claim language is suggested:

"The method according to claim 14, wherein the interaction in the contacting step (a) further comprises a second component that provides a detectable signal in response to the interaction of said polypeptide with said compound and wherein the determining step (b) further comprises the detection of the presence or absence of the signal generated in the contacting step (a)."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagedorn (WO9712033;IDS-4).

Hagedorn discloses a recombinant RNA-dependent RNA polymerase of hepatitis C virus that is 95.2% identical to the amino acid sequence of SEQ ID NO:4 (see attached search report for search parameters). Hagedorn further discloses methods for screening modulators of said

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polymerase comprising contacting potential modulators with said polymerase and a signal generating component.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Anthony Caputa, can be reached at (703)308-3995.


DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

April 21, 2000